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Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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ALEXANDRIA, VA 22314

F. WATKINS EXAMINER	
ART UNIT	PAPER NUMBER
PAL, A	11

1106  
DATE MAILED:

01/20/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☒ Responsive to communication filed on 12-22-1994 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 2 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☒ Claims 7-10 have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-6, 11-12 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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### PART III (PTOL 326): FINAL REJECTION

Applicant(s) may file the first response (37 CFR § 1.113) within a shortened statutory period (SSP) of **THREE MONTHS** without an extension of time.

See MPEP 710.01 to compute the end of the SSP, or extension thereof.

A first response filed after the SSP must be preceded or accompanied by an appropriate extension of time, up to a maximum of **THREE MONTHS**, as provided in 37 CFR § 1.136(a), with applicable extension fees (37 CFR § 1.17).

**IF A RESPONSE IS NOT FILED WITHIN SIX MONTH STATUTORY PERIOD,  
THE APPLICATION WILL BE ABANDONED.**

#### Examiner's amendment

To enhance the allowance of the claims, and to correct minor informalities, an examiner's amendment may be made without paid extension of time, provided (a) the first response is filed **within two months** from the date of mailing of the final rejection, or (b) the examiner's amendment date falls **within the three month shortened statutory period (SSP)** from the date of mailing of the final rejection. The date of an examiner's amendment **after the three month SSP must be** within the paid extension period (37 CFR § 1.136(a), and 37 CFR § 1.17). **or**, if not within the paid extension period, the Patent Office should be authorized to charge any applicable fee to a charge account. M.P.E.P. 706.07(f). An examiner's amendment can **NOT** be made **after six months** from the date of mailing, unless the application is kept in pending status (e.g., by filing an appeal).

#### Response to the Final Rejection

The first response filed by the Applicant(s) should preferably include all papers duly signed and in final form, preferably in one package, with applicants' remarks on the merit of the rejection(s) / examiner's action; and may include, if any:

- (1) Amendment to specification to update the status of parent/copending applications
- (2) Amendments to the claims indicating support in specification or another claim.
- (3) All petitions (including extension of time), with proper fees.
- (4) Complete prior art statement, including completed PTO-1449, copies of prior art.
- (5) Notice of appeal (and an appeal brief directed to finally rejected claims, if applicable).
- (6) Terminal disclaimer. Note MPEP 1490 and 37 CFR §3.73(b).
- (7) Any other pertinent objective or factual evidence rebutting the rejection. A declaration under 37 CFR § 1.131 or § 1.132 after final is considered **untimely**, without a showing under 37 CFR § 1.116(b), and will not be considered at this stage of prosecution, unless it is filed to overcome a new ground of rejection in this final rejection. MPEP 715.09, 716.

An interview is not normally granted after final rejection, unless the claims are amended following the guidelines below. A decision on the first paper(s) filed is taken by this Examiner within 2-5 working days from the date the application reaches the Examiner's desk.

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***Amendment after Final Rejection***

If an amendment to the finally rejected claims is proposed, applicant(s) are requested to indicate the antecedent basis for the proposed amendment in another finally rejected claim **and** in the specification. The proposed amendment to the finally rejected claims may not be entered (MPEP 714.13):

- (1) If there is no convincing showing under 37 CFR § 1.116(b) why the proposed amendment is necessary and was not presented earlier,
- (2) If the proposed amendment raises new issues (no antecedent basis in finally rejected claims) that would require further consideration and/or search.
- (3) If the proposed amendment introduces new matter to the claims and has no antecedent basis in finally rejected claims or in specification as originally filed.
- (4) If the proposed amendment is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- (5) If the amendment presents additional claims without cancelling a corresponding number of finally rejected claims. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599.

If a timely filed amendment places the application in condition for allowance, such an amendment will be entered as long as the application is pending, and the application will be promptly allowed.

If a timely filed amendment does NOT place the application in condition for allowance, but can be otherwise entered, the amendment will be entered only after the filing of an appeal, and it will be so indicated in an advisory action. If an amendment after final is filed close to the end of the SIX MONTH statutory period, applicants are urged to timely file a notice of appeal to avoid unintentional abandonment of the application.

**Proposed amendments are not generally entered in part.  
See MPEP 714.20**

***ACKNOWLEDGEMENT OF RECENTLY  
FILED PAPERS***

The request for reconsideration (along with the amendment and extension of time) filed December 22, 1994 is hereby acknowledged.

***CHANGE OF EXAMINER IN CHARGE  
OF THE APPLICATION***

Please note the CHANGE in Examiner in charge of the application. Previous examiner of record has retired from the Patent Office or the application has been reassigned to this examiner for enhancing the prosecution. **All future papers and enquiries related to this application should be sent to: Examiner Asok Pal, Art Unit 1106, Telephone Number 703 308-3809.**

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### CLAIMS PENDING IN THE APPLICATION

Claims 1-6 and 11-12 are now pending in the application. Claims 1, 2 and 11 are directed to the adsorbent composition comprising a high-silica zeolite and a heat-resistant oxide loaded with a noble metal. Claims 3-6 and 12 are directed to the honeycomb structure containing a high silica zeolite and an oxide with noble metal.

### REJECTION A

*Claims 1-6 and 11-12 are FINALLY rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Inoue (5,223,236) or over Toyota Jidosha (JA 89-197061/27).*

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue;
3. Resolving the level of ordinary skill in the pertinent art.

Evidence rising out of the so-called "secondary evidence or considerations", such as (a) commercial success, (b) criticality, (c) economy, (d) expert opinion supported by facts, (e) long felt need, and failure of others, (f) optimization, (g) recognition of the problem and solution, (h) radical departure from the convention, (i) unexpected results or development of properties, (j) recognition in the industry etc., whenever they appear in the record, have been considered as an integral part of the analysis of the obviousness. Before secondary considerations become relevant to the issue of obviousness, a nexus between the evidence of secondary considerations and the merit of the claimed invention must be established.

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Evaluations of the level of ordinary skill in the art requires considerations of such factors as (a) various prior art approaches, (b) types of problems encountered in the art, (c) rapidity with which innovations are made, (d) sophistication of technology involved, (e) educational background of those actively working in the field, and (f) recognition of the problem and failure of others to find a solution. The *person having ordinary skill in the art* has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

#### *The Invention As Claimed*

The claims are interpreted as broadly as permissible within the boundaries of the disclosure. The claims represent the "metes and bounds" of the invention. A limitation claimed in a dependent claim or a limitation disclosed, expressly or by implication, in the specification can not be read into other dependent claim(s) or into the independent claim(s). Applicant(s) are requested to interpret the following rejection keeping in mind the claims pending at this moment in the application.

Claims 1, 2 and 11 are directed to the adsorbent composition comprising a high-silica zeolite and a heat-resistant oxide loaded with a noble metal. Claims 3-6 and 12 are directed to the honeycomb structure containing a high silica zeolite and an oxide with noble metal. Applicants have amended the claims as three component system - zeolite, heat resistant oxide and the noble metal.

#### *The Teachings*

Reference Inoue (priority date December 18, 1989) teaches a catalyst composition comprising a zeolite, a heat-resistant oxide (column 3, lines 47-54), and a noble metal. The zeolites used in the reference has Si/Al ration higher than 40.

Toyota Jidosha teaches the composition comprising the zeolite, inorganic heat resistant oxides, such as silica, alumina, and a noble metal, such as Pt, Pd, Rh, Ir, Ru.

#### *The Difference*

The difference between the claimed invention and Inoue or Toyota Jidosha is essentially nil. Alternatively, the composition is applied to a honeycomb structure, which is well known in the art.

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### *Conclusion*

The embodiments of claims 1, 2 and 11 are clearly anticipated by Inoue or Toyota Jidosha..

*Alternatively*, in view of the difference between the subject matter *as a whole* sought to be patented and the *totality* of the teaching of prior art, *as established above*, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, to follow the teachings of Inoue or Toyota Jidosha and use the same composition, optionally with a honeycomb support for the same adsorbent application.

### *Motivation For Combining The References*

The motivation for the combination of references is not an issue here.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection.

Each claim has been considered and has been interpreted as broadly as possible. The independent claim(s) represent the invention(s) in their broadest scope. The dependent claims list several limitations of the corresponding broad independent claim, but the specification does not clearly establish either the criticalities of the limitations of the dependent claims in practicing the claimed invention(s), or the unexpected observations resulting from practicing the embodiments of the dependent claims.

The limitations in the dependent claims would have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have taken for granted. M.P.E.P. 706.02(a)

Even though the specific limitations of the dependent claims are not specifically taught in the prior art cited in the rejection, one of ordinary skill in the art would have obviously come up with a listing of such limitations as they were or would have been commonly practiced in the art. Listing of common features or limitations of an otherwise known process of the prior art is not considered patentable under 35 U.S.C. § 103.

If it is believed by applicant(s) that one or more specific limitation(s) in the dependent claim(s) are critical to the invention, applicants may indicate where in the specification their

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criticalities have been established and why they are not clearly obvious over the art of record or in view of the state of knowledge in the art at the time the invention was made.

The independent claim(s) may be amended to include the limitation(s) of one or more dependent claims(s) which are considered - and established in the specification or any subsequently filed declarations/affidavits - to be critical for the invention to succeed or be operable, and distinguish over the art of record.

**ALLOWABLE SUBJECT MATTER**

No claim contains any allowable subject matter. The rejection(s) above should be addressed.

**THIS ACTION IS MADE FINAL**

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION.**

**IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.**

**DISCLOSURE STATEMENT AFTER FINAL REJECTION**

A disclosure/prior art statement filed after the mailing of the final action is considered improper, unless the filing meets the following guidelines of 37 CFR § 1.97(d):

An information disclosure statement filed after the mailing date of either the final action under 37 CFR § 1.113 or the notice of allowance under 37 CFR § 1.311, whichever occurs first, but before the payment of the issue fee, must be accompanied by **all three of the following documents**:

- (i) A certification as specified in paragraph (e) of this section, and
- (ii) A petition requesting consideration of the information disclosure statement ,
- (iii) The petition fee as set forth in 37 CFR 1.17(i)(1).

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Original documents in **English** will be fully acknowledged. Original documents in languages **other than English** filed with or without (a) an English translation, or (b) an equivalent publication in English, or (c) an abstract in English, or (d) applicant's description of the relevancy of the document, or (e) a search report or comments by a foreign patent office indicating the relevancy by letters X, Y, A etc., will be acknowledged following the guidelines provided in M.P.E.P. 609.

A document cited *without date (month/year, and in some cases, the date)* of publication may not be acknowledged, but will be retained in the application. The date of publication is important particularly for Books, Journal Articles, Technical brochures, Trade Publications, Instructional manuals, papers presented in symposia and national meetings etc.

*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Asok Pal whose telephone number is (703) 308-3809.*



(Asok Pal)  
Primary Patent Examiner  
Art Unit 1106

ap:29  
January 18, 1995